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REMARKS

Claims 1-6, 8-16, and 18-20 are currently pending in this application. Applicants have amended claims 1-6, 8-16, and 18-20 to address Examiner's concerns in the March 18, 2005 Office Action. Applicants maintain that the amendments are well-supported by the originally-filed specification and that there is no issue of new matter. Accordingly, Applicants respectfully request the entry of this Amendment.

Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claims 1 and 11 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner states:

Claims 1 and 11 recite a method/system which allows unlimited users to chat with each other, [but] the specification [does] not describe how the method and system of the instant application would be able to support unlimited users. Since all existing computing systems have finite resources, it is not possible for any method/system to be able to support an unlimited number of users. Thus, for examining purposes, "unlimited users" [should] read "multiple users".

In response, Applicants have replaced "unlimited" in claims 1 and 11 with "multiple" per Examiner's suggestion.

The Examiner rejected claims 2, 4, 12, and 14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner states:

Claims 2 and 12 [recite] the limitation[s] "the page" in line 2, "the chatter list" and "the Server" in line 3, and "the byte-array" in line 4. Claims 4 and 14 [recite] the limitation[s] "the chatroom screen"

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in line 3 [and] "the number of webcam images" in line 4. There is insufficient antecedent basis for [these] limitations[s] in the claim[s].

In response, Applicants have amended the claims to provide proper antecedent basis for the limitations. Specifically, Applicants have replaced "page" and "chatroom screen" with "user interface screen."

Claim Rejections - 35 U.S.C. § 102(e)

To anticipate a claim, the reference must teach each and every element of the claim.

"A claim is anticipated only if each and every element as set forward in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner rejected claims 1 and 11 under 35 U.S.C. 102(e) as being anticipated by Tang, et al., U.S. Patent No. 5,793,395 (Tang). In particular, the Examiner stated the following regarding claim 1:

Tang disclose[s] a method which allows multiple users to chat with each other (Figure 5[;] column 3[,] lines 20-25) while displaying live webcam images in uniform size of more than one selected user (Figure 5[,] sign 14[;] Figure 10[,] sign 121[;] column 3[,] lines 39-46[;] column 5[,] lines 29-32) within an internet chatroom environment (Figure 10[,] signs 123, 133[;] column 2[,] lines 29-41[;] column 9[,] lines 26-36[;] column 11[;] lines 37-40)..

In response, Applicants have amended claim 1 to include a distinguishing element of the invention not disclosed by Tang. In particular, Tang fails to disclose the step of displaying a

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list of users whose images are not shown but are online in the chatroom, with said list being displayed in the same user interface screen as the chatting means and webcam images. See e.g., Tang, Figure 5. Support for Applicants' amendment may be found, for example, in Figure 5 of the originally-filed application.

Additionally, the Examiner stated that "[r]egarding claim 11, the system corresponds directly to the method of claim 1, and thus is rejected using the same rationale.

In response, Applicants have amended claim 11 to include the distinguishing element discussed above and traverse the Examiner's rejection using the same rationale discussed above.

In conclusion, Tang neither discloses every element of claim 1 nor claim 11. Accordingly, Applicants request that the Examiner withdraw this ground of rejection.

Claim Rejections - 35 U.S.C. § 102(b)

The Examiner also rejected claims 1-2, 4-6, 8-9, 11-12, 14-16, and 18-19 under 35 U.S.C. 102(b) as being anticipated by Ludwig, et al., U.S. Patent No. 5,854,893 (Ludwig). In particular, the Examiner stated the following regarding independent claim 1:

Ludwig disclose[s] a method which allows multiple users to chat with each other (Figures 8A-8C[;] column 6[,] lines 11-21) while displaying live webcam images in uniform size of more than one selected user (Figures 8A-8C[;] Figures 31B-31C[;] Figure 18A[,] sign 500[;] column 24[,] lines 21-36) within an internet chatroom environment (Figure 4[;] column 3[,] lines 36-46[;] column 8[,] lines 16-26).

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In response, Applicants have amended independent claim 1 to include a distinguishing element of the invention not disclosed by Ludwig. In particular, Ludwig fails to disclose the step of displaying a list of users whose images are not shown but are online in the chatroom, with said list being displayed in the same user interface screen as the chatting means and webcam images. See e.g., Ludwig, Figure 8A-8C. Support for Applicants' amendment may be found, for example, in Figure 5 of the originally-filed application.

Ludwig discloses a conference screen with buttons that can be used to place individual conference participants on hold or to provide a close-up image of a single individual in place of the video mosaic. Ludwig, Figures 8A-8C and column 24, lines 16-36. However, a review of Ludwig's disclosure reveals that Applicant's invention is significantly different from that of Ludwig because of its use. Ludwig's invention was developed to facilitate business communications between coworkers, affiliates, or other professionals. Communication in such a context is thus limited to a closed number of known individuals.

On the other hand, Applicants invention is designed to facilitate social communication in an internet chatroom environment. It should be noted that the word "internet" is not even disclosed once in Ludwig. Communication in an internet chatroom environment is open to an indefinite number of known and unknown individuals. It can be equated to that to a public space, such as a park, where, subject to certain restrictions, any who desires can enter and converse with others who are present. Thus, to facilitate communication in an internet chatroom environment, Applicants have provided a list of users who are online in the chatroom but whose images are not shown. Users then have the flexibility of selecting

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the number of images and users they wish to view without disrupting the chatroom communication.

In contrast, Ludwig only discloses a list of individuals (whose images are not shown) in the conference screen when such individuals have been put on hold, and thus temporarily removed from the conference. Ludwig, Figure 8A-8C and column 24, lines 16-36. Such individuals on hold are thus not "online in the chatroom" as required by Applicants' amended claim 1. Therefore, Ludwig fails to disclose the step of displaying a list of users whose images are not shown but are online in the chatroom, with said list being displayed in the same user interface screen as the chatting means and webcam images.

Additionally, the Examiner stated that "[r]egarding claim 11 ..., the system corresponds directly to the method of claim 1 ..., and thus [is] rejected using the same rationale.

In response, Applicants have amended claim 11 to include the distinguishing element discussed above and traverse the Examiner's rejection using the same rationale discussed above.

Dependent claims 2, 4-6, 8-9, 12, 14-16, and 18-19 have also been rejected by the Examiner as being anticipated by Ludwig. However, as discussed above, Ludwig failed to disclose every element of independent claims 1 and 11. Because the above dependent claims depend either directly or indirectly on independent claims 1 and 11 and thus have additional limitations, Ludwig necessarily fails to anticipate said dependent claims.

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In conclusion, Ludwig neither discloses every element of claim 1 nor claim 11. Accordingly, Applicants request that the Examiner withdraw this ground of rejection.

Claim Rejections - 35 U.S.C. § 103(a)

The basis for all obviousness rejections is set forth under 35 U.S.C. § 103(a), which provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)). If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. Manual of Patent Examining Procedure, §2142.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. Manual of Patent Examining Procedure, §2143.

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The Examiner rejected claims 3 and 13 under 35 U.S.C. 103(a) as being unpatentable over Ludwig in view of Moore, et al., U.S. Patent No. 6,310,601 (Moore).

Additionally, the Examiner rejected claims 5-6, 8-10, 15-16, and 18-20 under 35 U.S.C. 103(a) as being unpatentable over Tang as applied above and further in view of the invention's background.

As discussed supra, Tang and Ludwig fail to disclose the list of users whose images are not shown but are online in the chatroom, with said list being displayed in the same user interface screen as the chatting means and webcam images.

Accordingly, Ludwig and Moore, when combined, fail to teach all the limitations of independent claims 1 and 11, and thus, necessarily fail to teach all the limitations of dependent claims 3 and 13 since these claims have all the elements of claim 1 and claim 11, respectively, in addition to further elements. Therefore, the Examiner has not satisfied this criterion of a prima facie case, and it is unnecessary for Applicants to address the remaining criteria of motivation to combine and reasonable expectation of success.

Similarly, Tang as applied above and further in view of the invention's background, fails to teach all the limitations of independent claims 1 and 11, and thus, necessarily fails to teach all the limitations of dependent claims 5-6, 8-10 and 15-16, 18-20 since these claims have all the elements of claim 1 and claim 11, respectively, in addition to further elements. Therefore, the Examiner has not satisfied this criterion of a prima facie case, and it is unnecessary for Applicants to address the remaining criteria of motivation to combine and reasonable expectation of success.

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In conclusion, the Examiner has not fulfilled the burden of establishing a prima facie case of obviousness. Accordingly, a rejection of the above claims based on obviousness is improper. In light of the foregoing reasons, Applicants respectfully requests the withdrawal of this ground of rejection under 35 U.S.C. 103(a).

CONCLUSION

In summary, Applicants believe that all grounds of rejections have been addressed and earnestly request the Examiner to place this application in condition for allowance.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

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